

### **REMARKS**

In the Final Office Action,<sup>1</sup> the Examiner objects to the specification as failing to provide antecedent basis for claims 21, 32, and 48; rejected claims 1, 3-6, 9-11, 13-15, 18-21, 23, 25, 31, 32, 34, 36-38, 40, 41, 43, 44, and 46-48 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent 7,111,042 to Kikugawa ("Kikugawa") in view of U.S. Patent No. 6,011,895 to Abecassis ("Abecassis"), and further in view of U.S. Patent 6,983,483 to Maze et al. ("Maze"); rejected claims 2, 12, 24, 35, and 42 under 35 U.S.C. § 103(a) as unpatentable over Kikugawa, Abecassis, and Maze, and further in view of U.S. Patent No. 6,424,997 to Buskirk, Jr. et al. ("Buskirk"); and rejected claims 26-29 under 35 U.S.C. § 103(a) as unpatentable over Kikugawa, Abecassis, and U.S. Patent No. 7,107,271 to Aoki et al. ("Aoki"), and further in view of Maze.

By this reply, Applicants propose to amend claims 1-3, 10-13, 19-21, 23, 24, 26, 28, 29, 31, 32, and 34, and to cancel claims 27, 41-44, and 46-58. Claims 1-5, 9-15, 18-21, 23-26, 28, 29, 31, 32, 34-38, and 40 would be pending after entry of this Amendment. Support for the claim amendments can be found, for example, at paragraphs 328-383 and in the corresponding figures of the specification.

### **Interview Summary**

As an initial matter, Applicants thank Examiner Morrison for the courtesies extended to Applicants' representative during the telephonic interview of October 9, 2009. During the interview, Applicants' representative and the Examiner agreed that paragraphs 153 and 386 provide examples of statutory types of computer-readable

---

<sup>1</sup> The Final Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

storage media under 35 U.S.C. § 101, and that the specification therefore provides antecedent basis for claims 21 and 32. Accordingly, the Examiner agreed to withdraw the objection to the specification. It was also agreed that dependent claims 26 is allowable over the prior art of record, and that amending independent claim 23 to incorporate the “dictionary data” subject matter from dependent claim 26 would render independent claim 23 allowable over the prior art of record.

### **Objection to the Specification**

At page 2, the Final Office Action objects to the specification as failing to provide antecedent basis for the computer-readable storage media of claims 21 and 32. As discussed during the interview, however, at least paragraphs 153 and 386 provide examples of statutory types of computer-readable media under 35 U.S.C. § 101. Accordingly, the Examiner agreed that specification provides antecedent basis for the claims, and that the objection would be withdrawn.

### **Rejection Under 35 U.S.C. § 103**

Applicant respectfully traverses the rejection of claims 1, 3-5, 9-11, 13-15, 18-21, 23, 25, 31, 32, 34, 36-38, and 40 under 35 U.S.C. § 103(a) as unpatentable over Kikugawa in view of Abecassis, and further in view of Maze.

### **The Claims Should Be Considered as a Whole**

Initially, as noted in Applicants reply filed June 2, 2009 at pages 3-4, “the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP § 2141.02(I) (emphasis added). Thus, it is improper to “dissect a claimed

invention into discrete elements and then evaluate the elements in isolation.” MPEP § 2106(II)(C) (emphasis added).

Applicants respectfully submit that the Final Office Action fails to consider the claims as a whole and, instead, improperly dissects the claims and analyzes the claimed elements in isolation. For example, at page 4, the Final Office Action states, “Kikugawa does not explicitly indicate ‘program’ or ‘for obtaining information about a program’ . . . . Abecassis discloses ‘program’ . . . and ‘for obtaining information about a program’ . . . .” Similarly, at page 5, the Office Action states, “[n]either Kikugawa nor Abecassis explicitly indicate ‘television.’ However, Maze discloses ‘television’ . . . .”

Claim 1, however, does not recite merely “program,” “for obtaining information about a program,” and “television.” Claim 1 recites, for example, “searching the accumulated television program information for television program information associated with the interest words corresponding to the selected topics in response to the search request.” Thus, instead of analyzing the claims as a whole, the Final Office Action seems to improperly extract the claimed elements (e.g., “television,” “program,” and “for obtaining information about a program”) from their context in the claims and examine the claim fragments in isolation.

In response to this reasoning, the Office Action asserts, “[w]hile applicant argues that dissecting a claimed invention and evaluating the elements in isolation [*sic*], it is noted that the proper 35 USC 103 rejection determines obviousness by finding that of one of ordinary skill the art would have combining [*sic*] the cited references to teach the references [*sic*]. Therefore, applicants argument is whether there was proper motivation to combine the cited references.” Page 21. Applicants respectfully disagree.

Applicants submit that there is a difference between considering what a claim means as a whole and evaluating whether one of ordinary skill in the art would have been motivated to combine certain references to achieve the invention recited by that claim. An obviousness analysis under § 103, including determining whether there would be motivation to combine certain references, cannot begin without first determining the meaning of the claim as a whole. Otherwise, the actual meaning of the claim is lost and it is impossible to “[a]scertain[] the differences between the claimed invention and the prior art” (MPEP § 2141(II)), which is one of the basic factual inquiries under *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966).

**The Cited References Fail to Disclose or Suggest the Claim Elements**

Amended independent claim 1 recites an information search system, comprising,  
for example,

means for grouping the user’s electronic mail into topics;

means for extracting from the user’s electronic mail interest words corresponding to the topics for obtaining information about a television program;

means for generating topic files for the topics, the topic files including word vectors containing the interest words and feature vectors containing weights of the interest words, the weights indicating the degree of relevance of the interest words to the topics; . . .

means for calculating evaluation values for the topics based on the weights of the interest words and for selecting topics with an evaluation value above a threshold; and

means for sending a request to search television program information based on the interest words corresponding to the selected topics.

Kikugawa discloses, “an electronic bulletin board system, which communicates with a user computer via a network, and mediates information exchange therebetween

by an electronic bulletin board function.” Abstract. Specifically, in Kukugawa, “when an e-mail . . . is sent from a user computer, the mail server refers the e-mail text to the notable words collection. When the referred e-mail text has a notable word . . . an appropriate URL for the notable word is set as a link destination. And the mail server sends the e-mail, to which the link destination is set, to the Internet directing to the e-mail address of the recipient.” Col. 8, ll. 16-24.

Thus, Kikugawa’s system reviews an e-mail to identify any “notable words.” If the e-mail contains a notable word, “the notable word in the message [in the e-mail] text is converted into a hypertext format having the URL to which the word is linked.” Abstract. That is, Kikugawa automatically inserts hyperlinks into an e-mail when the e-mail contains a “notable” word by converting the word into a hyper text link. Kikugawa, however, fails to disclose or suggest any of “grouping the user’s electronic mail into topics,” “extracting from the user’s electronic mail interest words corresponding to the topics for obtaining information about a television program,” “generating topic files for the topics, the topic files including word vectors containing the interest words and feature vectors containing weights of the interest words, the weights indicating the degree of relevance of the interest words to the topics,” “calculating evaluation values for the topics based on the weights of the interest words and . . . selecting topics with an evaluation value above a threshold,” and “sending a request to search television program information based on the interest words corresponding to the selected topics,” as recited by amended independent claim 1.

Abecassis fails to remedy at least the above-noted deficiencies of Kikugawa. In Abecassis, “each segment [of a program] is analyzed as to subject matter and assigned

the necessary keyword . . . [which] provides the capability for inhibiting the viewing of undesirable subject matter . . . .” Col. 7, ll. 8-11 and 16-18. Programs are then played on a segment-by-segment basis in accordance with a user’s preferences. Col. 9, ll. 53-64; and col. 13, ll. 13-21.

Thus, Abecassis discloses a custom programming censorship system “permitting the viewer to decide for themselves the level of censorship that they may desire.” Col. 8, ll. 25-26. Abecassis, however, also fails to disclose or suggest at least the above-noted elements of amended independent claim 1.

Maze fails to remedy the above-noted deficiencies of Kikugawa and Abecassis. Maze discloses an “apparatus . . . for searching the [television program] listing for specific user-entered information, and upon successful conclusion to the search, . . . [scheduling] the tuning of the desired program, or in the alternative, notif[ing] the viewer of the availability of the program” (emphasis added). Abstract. That is, Maze discloses a system that allows a user to manually search television program listings by entering search terms. See, e.g., col. 2, l. 33 - col. 3, l. 25. Maze, however, fails to disclose or suggest at least the above noted features of amended independent claim 1.

#### **There Would Have Been No Motivation to Combine the References**

Notwithstanding the above-noted deficiencies of the prior art, there would have been no motivation to modify the prior art as proposed by the Office Action. See MPEP § 2143. Starting from Kikugawa, one of ordinary skill in the art would be focused ways to insert hyperlinks into e-mails containing certain desired words, and would have no need for Abecassis’ unrelated television programming censorship method. Thus, Abecassis would not have logically commended itself to one of ordinary skill in the art

starting from Kikugawa, and there would have been no motivation to make the proposed combination. See MPEP § 2143.

Moreover, Applicants submit that the rejection of claim 1 under § 103 is improper because the cited references are directed to non-analogous prior art. See MPEP § 2141.01(a). As set forth above, Kikugawa is directed to a system for automatically inserting hyperlinks into an e-mail or a bulletin board posting when the e-mail or bulletin board posting contains certain keywords. In contrast, Abecassis discloses a system that custom-censors television programming in accordance with a user's profile. One of ordinary skill in the art would not have found it obvious to look to such disparate technologies in arriving at the subject matter of claim 1. That is, one of ordinary skill in the art would not have found it obvious to look to Abecassis' programming censorship system in trying to modify or improve Kikugawa's system for inserting hyperlinks into e-mails.

For the above reasons, independent claim 1 is allowable over Kikugawa, Abecassis, and Maze. Independent claims 11, 20, and 21, though of different scope from claim 1, are allowable over Kikugawa, Abecassis, and Maze for at least similar reasons as claim 1. In addition, independent claim 23, 31, 32, and 34 have been amended to recite the "dictionary data" subject matter based on dependent claims 26 and 27 (now canceled), which the Examiner indicated in the interview would render the independent claims allowable over the prior art of record. Accordingly, amended independent claims 23, 31, 32, and 34 are also allowable over the cited prior art references. Dependent claims 3-5, 9, 10, 13-15, 18, 19, and 36-38 are allowable at least due to their dependence from one of the independent claims. Accordingly,

Applicants respectfully request the withdrawal of the rejection of claims 1, 3-5, 9-11, 13-15, 18-21, 23, 25, 31, 32, 34, 36-38, and 40.

Applicant respectfully traverses the rejection of dependent claims 2, 13, 24, and 35 under 35 U.S.C. § 103(a) as unpatentable over Kikugawa, Abecassis, and Maze, and further in view of Buskirk.

Dependent claims 2, 13, 24, and 35 are allowable over Kikugawa, Abecassis, Maze and Buskirk inasmuch as Buskirk fails to remedy the deficiencies of Kikugawa, Abecassis, and Maze discussed above in connection with the independent claims.

Applicant respectfully traverses the rejection of dependent claims 26-29 under 35 U.S.C. § 103(a) as unpatentable over Kikugawa in view of Abecassis, and further in view of Aoki.

Dependent claims 26-29 are allowable over Kikugawa, Abecassis, Maze, and Aoki inasmuch as Aoki fails to remedy the deficiencies of Kikugawa, Abecassis, and Maze discussed above in connection with the independent claims.

In view of the foregoing, Applicant respectfully requests reconsideration of this application, withdrawal of the rejections, and the timely allowance of the pending claims. If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, the Examiner is kindly invited to contact the undersigned at 202.216.5118.

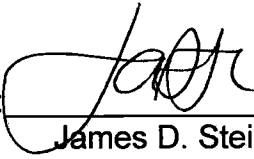


Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: October 19, 2009

By:   
James D. Stein  
Reg. No. 63,782  
202.216.5118